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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,507	11/14/2003	Robert P. Breazeale JR.	S-830	9944
50779	7590	11/21/2005		
WORLD FACTORY, INC. c/o LAW OFFICES OF JAMES E. WALTON, P.L.L.C. 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			EXAMINER PAYER, HWEI SIU CHOU	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,507

Applicant(s)

BREAZEALE, ROBERT P.

Examiner

Hwei-Siu C. Payer

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-34 is/are pending in the application.
- 4a) Of the above claim(s) 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **Detailed Action**

Applicant's election with traverse of invention Group II (claims 26-31) in the reply filed on November 17, 2005 is acknowledged. The traversal is on the ground(s) that the election is not an acquiescence in the propriety of restriction or in the accuracy in the determination and /or identification of the alleged "distinct inventions" in the subject Application. This is not found persuasive because for the inventions that are related as product and process of use can be shown to be "distinct" if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In this instant, the examiner has shown that the product as claimed can be used in a materially different process of using that product, and that meets the requirement of distinctness.

The requirement is still deemed proper and is therefore made FINAL.

It is noted invention Group I relating to a guard (subcombination) and invention Group II relating to a reciprocating saw (combination) are not restrictable and have been examined together. The non-elected claims 32-34 have been withdrawn from further consideration.

### **Claims Rejection - 35 U.S.C. 112, second paragraph**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21, 22, 24, 25 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 21 is vague and indefinite. It is not clear what structure of the guard is being claimed therein.

(2) The scope of claim 22 is confusing. While the preamble calls for a guard, the main body of the claimed clearly recites the reciprocating saw as part of the claimed combination.

(3) Claims 24 and 25 are vague and indefinite. Exactly what structure of the guard is being claimed therein? It is not understood how the battery-powered reciprocating saw and the statement of intended use have any structure import on the claimed guard.

(4) In claim 31, it is not understood how the guard member is configured to prevent debris from collecting thereon during use.

#### **Claims Rejection - 35 U.S.C. 102(b)**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Evich (U.S. Patent No. 2,984,005).

The scope of claims 22, 24 and 25 is vague. For examining purposes, the claimed invention has been interpreted as a subcombination (i.e. a guard) rather than a guard in combination with a reciprocating saw. Therefore, the reciprocating saw has no patentable import on the structure of the claimed guard.

Evich shows a rubber guard (65) for a reciprocating cutting tool. The guard (65) comprises an attachment portion (i.e. the periphery portion) configured for attachment to the exterior of the reciprocating cutting tool (see Fig.5); a seal portion; an aperture extending through the seal portion, the aperture being configured to allow at least one blade (32') of the reciprocating cutting tool to extend therethrough while maintaining a sealing contact between the seal portion and the at least one blade (32'), such that liquids and particulate matter are prevented from entering the reciprocating (see column 4, lines 1-8) as claimed.

Further, the attachment portion of Evich's guard (65) can be secured by press fitting against a reciprocating saw depending upon the size and shape of the saw housing, if such a reciprocating saw is so provided, and also such reciprocating saw can be battery-operated if so desired. Moreover, Evich's guard is fully capable of being used in field-dressing an animal carcass as claimed.

### **Claims Rejection - 35 U.S.C. 103(a)**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (U.S. Patent No. 3,203,095) in view of Evich (U.S. Patent No. 2,984,005) and Taggart (U.S. Patent No. 2,990,614).

Nelson shows a reciprocating saw comprising a housing (10) and at least one blade (12) extending from the housing (10) substantially as claimed except it lacks a guard member.

Evich shows a reciprocating cutting tool comprising a rubber guard member (65) connected to a housing of the cutting tool and having a slot for receiving a reciprocating blade therethrough and for preventing particulate matter from entering the reciprocating cutting tool.

It would have been obvious to one skilled in the art to modify Nelson by providing the reciprocating saw with a guard member to facilitate preventing foreign matter from entering the interior of the housing as taught by Evich.

Also, Taggart teaches it is desirable to have a guard (40) detachably connect to a reciprocating cutting tool to enable replacement of the guard.

In view of this teaching, it would have been obvious to one skilled in the art to further modify Nelson by detachably connecting the guard member to the reciprocating saw for the reason set forth.

3. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (U.S. Patent No. 3,203,095), Evich (U.S. Patent No. 2,984,005) and Taggart (U.S. Patent No. 2,990,614) as applied to claim 26 above, and further in view of Underthun (U.S. Patent No. 6,487,779).

Nelson's reciprocating saw as modified above shows all the claimed structure except the saw is not powered by a rechargeable battery.

Underthun shows a reciprocating saw comprising a rechargeable battery (40) as a power source.

It would have been obvious to one skilled in the art to further modify Nelson by providing the reciprocating saw with a rechargeable battery (40) to facilitate powering a motor of the reciprocating saw to drive the saw blade as taught by Underthun.

4. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (U.S. Patent No. 3,203,095), Evich (U.S. Patent No. 2,984,005) and Taggart (U.S. Patent No. 2,990,614) as applied to claim 26 above, and further in view of Walker (U.S. Patent No. 2,348,429).

Nelson's reciprocating saw as modified above shows all the claimed structure except the connection between the guard member and the saw housing is not by means of a press fit.

However, it is notoriously old and well known in the art to connect two elements by a press fit as evidenced by Walker (see column 2, lines 41-46).

Therefore, it would have been obvious to one skilled in the art at the time this invention was made to further modify Nelson by press fitting the guard member to the saw housing to facilitate a quick and easy attachment and detachment thereof.

#### **Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

H Payer  
November 15, 2005

*Hwei-Siu Payer*

Hwei-Siu Payer  
Primary Examiner